

Docket No.
IDS-14402/14

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/829,032	04/09/2001	Schulterbrandt	25006	3632	8394

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**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.
IDS-14402/14

In Re Application Of: **Rivin**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/829,032	04/09/2001	Schulterbrandt	25006	3632	8394

Invention: **PORTABLE SIGN SUPPORT APPARATUS**

TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:

Dated: **Jan. 31, 2005**

Signature

**John G. Posa
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Sheryl L. Hammer

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Venegas, Jr.

Serial No.: 09/829,032

Group No.: 3632

Filed: April 9, 2001

Examiner: Schulterbrandt

For: PORTABLE SIGN SUPPORT APPARATUS

APPELLANTS' BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 10 claims. Claims 2-4 and 10 were canceled by amendment in January 2004. Claims 1 and 5-9 are pending and under appeal. Claim 1 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 provides a support apparatus comprising a sign having an elongated post with a geometric cross section and a plurality of spaced-apart through-holes; and a base comprising a hollow fillable body having a bottom portion adapted to rest on a ground surface and a top portion transitioning into a collar, the collar including a bore dimensioned to receive the geometric cross section of the post and at least one aperture configured to align with one of the spaced-apart through-holes of the post when it is received into the collar, and a fastener received by the aperture and through holes to hold the sign in an aligned, upright position. (Specification, page 5, line 16; Figure 2).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 1 and 5-9 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,220,740 to Brault in view of U.S. Patent Nos. 3,119,588 to Keats and 6,401,658 to Teets.

VII. ArgumentDrawings

The objection to the drawings concerned claim 10, which was canceled by amendment in January 2004 rendering this objection moot.

A. Rejection of Claims 1 and 5-9 under 35 U.S.C. §103(a)

Claims 1 and 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,220,740 to Brault in view of U.S. Patent Nos. 3,119,588 to Keats and 6,401,658 to Teets.¹ The Examiner concedes that primary reference, Brault, “does not teach a plurality of through holes in the post or a post hole lined with a collar hole,” but argues that it would be obvious to one of ordinary skill in the art to modify Brault to have multiple holes for adjusting the height of the sign (20) as taught by Keats, and then it would have been obvious to modify Brault to better secure Brault’s post (18) to the

¹ This is apparently two separate rejections in the same paragraph; that is, it is NOT a rejection under 35 U.S.C. §103(a) over U.S. Patent No. 5,220,740 to Brault in view of U.S. Patent No. 3,119,588 to Keats and *further in view* of U.S. Patent No. 6,401,658 to Teets.

collar by using a fastener into through holes, as taught by Teets. Appellant respectfully disagrees, and argues that the Examiner has applied the wrong standard in this case.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, there are no teachings or suggestions from the prior art in support of the Examiner's proposed combinations. Brault contains no disclosure regarding "height adjustment" or a "more secure" connection.

The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Moreover, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In this case, it is clear from the disclosure and specification of the '740 patent to Brault that the securement mechanism shown in Figure 5 is not only adequate but preferred.

"The post 18 which is adapted to support an item such as the sign 20 in Figure 1, is fittingly adapted to be mounted in the aperture 16 and be upstandingly retained thereinto. ... The post 18 is additionally held in an upstanding position by a corresponding aperture 60 in a recessed portion of the bottom surface 26. The bottom of the post 18 is vertically supported by a plate 62 threadedly held to the bottom surface 26 by a pair of wing nuts 64." ('740 patent, col. 3, lines 10-21)

There is absolutely no teaching or suggestion whatsoever of height adjustment in general, or a post with a plurality of holes that are in alignment with an aperture in a collar securement purposes.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

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Date: Jan. 31, 2005

APPENDIX A**CLAIMS ON APPEAL**

1. Support apparatus comprising:
a sign having an elongated post with a geometric cross section and a plurality of spaced-apart through-holes; and
a base comprising:
a hollow fillable body having a bottom portion adapted to rest on a ground surface and a top portion transitioning into a collar,
the collar including a bore dimensioned to receive the geometric cross section of the post and at least one aperture configured to align with one of the spaced-apart through-holes of the post when it is received into the collar, and
a fastener received by the aperture and through holes to hold the sign in an aligned, upright position.
5. The portable sign support apparatus of claim 1, wherein the base has one or more grasping handles.
6. The portable sign support apparatus of claim 1, further including a set of wheels associated with the bottom portion.
7. The portable sign support apparatus of claim 1, wherein the base is fillable with a liquid ballast.
8. The portable sign support apparatus of claim 7, wherein the base is fillable through the bore in the collar portion.
9. The portable sign support apparatus of claim 7, wherein the base is fillable through a sealable opening.

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APPENDIX B

EVIDENCE

None.

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APPENDIX C

RELATED PROCEEDINGS

None.